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09/445,065	12/01/1999	STEFAN BODENSCHATZ	BEIERSDORF-5	9425

7590

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EXAMINER

POTHIER, DENISE M

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 10/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/445,065

Applicant(s)

BODENSCHATZ ET AL.

Examiner

Denise M Pothier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 28 June 2002 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Summary***

1. On January 16, 2002, an office action was sent to Applicants, rejecting claims 1-20. Applicants responded on June 28, 2002, amending claims 1, 4, 7, 9, and 12.

### ***Drawings***

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 6-28-02 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the support strap splitting and then reconnecting to the support strap at the location shown in Figure 5. In addition, proposed figure 5 does not show the support strap dorsally on the thorax as described on page 4, lines 1-2. Rather, the strap is located on the neck or cervical vertebrae.

### ***Specification***

3. The amendment filed 6-28-02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: that the first end is split into two *forks* as recited in claim 9. Page 3, lines 38-39 of the original specification describes the support strap is designed partially divided into two parts.

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Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The first end *split into two forks* immediately after the point at which it is attached to the upper arm part. See the above discussion regarding what the original specification does support and what the inventor had possession of as of the filing of the application.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation, "said first end is split into two forks immediately after the point at which it is attached to said upper arm part" in lines 3-4. Do Applicants mean that the first end splits or forks immediately after the point? How does the end split into *two forks*?

***Claim Rejections - 35 USC § 102***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1, 3-6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Abolina (SU 321252). See paragraph 16 of the previous office action.

***Claim Rejections - 35 USC § 103***

10. Claims 1-2 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munoz in view of Abolina. See paragraph 18 of the previous office action.

11. Claims 11-12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munoz in view of Abolina as applied to claim 1 above, and further in view of Johnson. See paragraph 19 of the previous office action.

12. Claim 9, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Abolina in view of Verter (4,446,858). Abolina discloses the support strap has a first end attached to the upper arm and a second end attached to the forearm part. However, Abolina does not disclose the first end splits or forks immediately after the point at which it is attached to the upper part. Verter teaches in column 3, lines 55-64 that it is known in the shoulder support and sling art to use two straps immediately after where the straps are connected to the shoulder support in order to allow shoulder portion to be adjusted and secured to any sized patient. Thus, one having ordinary skill in the art would have known to split or fork the strap immediately after the point at which the strap of Abolina is attached to the upper arm

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part in order to allow for adjustment and to secure the upper part of Abolina having a recess adapted to fit over and enclose the shoulder joint to any sized user.

13. Claims 13-15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abolina in view of Ford. See paragraph 20 of the previous office action.

14. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abolina in view of Ford as applied to claim 13 above, and further in view of Cherubini. See paragraph 21 of the previous office action.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Carlson (6,152,891) discloses the state of the art of slings with straps that split or divide immediately after the connection to a shoulder cap.

### ***Response to Arguments***

16. Applicant's arguments filed 6-28-02 have been fully considered but they are not persuasive. Applicants argue that Abolina does not include both a support strap and a holding strap. The Examiner disagrees. The figures of Abolina disclose both at least two straps, including a support strap (strap that 3 points to) "being arranged on the upper arm part (part of 2) and a holding strap (one of the 5s located on 1) "being arranged on the forearm part. Thus, the Examiner disagrees that the Abolina shows only "one strap."

The Examiner is also unpersuaded by Applicants' remarks that Abolina is a "broken arm support" and not a bandage. During examination, claim limitations are to be given their broadest reasonable reading in light of the specification. In re Zletz, 893

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F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Applicants have used the term, "bandage," to include a device that has upper and lower parts made from a thermoformable foam and/or plastic (see p. 5, lines 30- page 6, line 7). As such, the term, bandage, in the claims is to be defined with the same breadth. Given this broad reading, Abolina is a bandage with an upper and lower parts.

With respect to Munoz, the Examiner disagrees that the reference does not have a holding strap for fixing the forearm in position. See element 44 in Figure 4. In addition, there is no limitation in claims 1-2 and 7-8 regarding a connecting strap and the Examiner has not suggested replacing the rigid bar of Munoz with a connecting strap. Abolina is only cited to teach the inclusion of half shells. Thus, the discussion of the connecting strap and the remarks will not be further addressed.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Denise M. Pothier whose telephone number is 703.308.0993. The examiner can normally be reached on Monday-Thursday and alternate Fridays. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist of Technology Center 3700, whose telephone number is (703) 308-1148.

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Denise Pothier  
Primary Examiner  
September 25, 2002

A handwritten signature in black ink, appearing to be 'dp' or a similar stylized monogram, written vertically.